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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,738	07/01/2003	Bruce G. Johnson	10012473-2	2553

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EXAMINER

TRAN, LY T

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/611,738	JOHNSON, BRUCE G.	
	Examiner	Art Unit	
	Ly T TRAN	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 33-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_                      6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 33, 36-38, 41, 42 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyake (JP3-284948).

With respect to claims 33, 41 and 51, Miyake discloses a method of printing with an ink jet comprising:

- A supply of ink liquid ink comprising a carrier fluid (Fig.1: element 1)
- An ink jet head using the ink for printing images on a transfer member that is adjacent to the print head and moveable with respect to the print head (Fig.1: 1, Abstract);
- Evaporating some of carrier fluid from the image as the transfer member moves between the print head and a position at which the image is transferred from the transfer member to a sheet of the print medium and delaying transfer of the image from the transfer member to the sheet to allow evaporation of carrier fluid from ink of image (Abstract, because the ink is ejected on the drum then transfer to the paper, delaying is occurred)

- The transferring the printed image from the transfer member to a sheet of the print medium (Fig.1: element 2, 5);
- Wherein the method does not include curing the ink with electromagnetic radiation (Abstract discloses the dryer 3 to evaporate the moisture in the ink therefore, no curing the ink with radiation);
- The method does not include applying a charge to a surface of the carrier fluid on the transfer member (Fig.1, Abstract)

With respect to claim 36, Miyake discloses transfer member comprises a drum (Fig.1: element 10).

With respect to claim 38, Miyake discloses ink jet head comprises a page width array (Fig.1: element 1)

With respect to claim 40, Miyake discloses a pinch roller for facilitating transfer of an image from the transfer member to the sheet of print medium (Fig.1: element 4).

With respect to claim 42, Miyake discloses heating the transfer member (Fig.1: element 3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake (JP 3-284948) in view of Roth (USPN 6,354,700) and Dolan et al. (USPN 5,862,753).

Miyake fails to teach the cleaning member and using transfer belt.

Roth discloses a cleaning member to clean the transfer member (Fig.1: element 30)

Miyake discloses the claimed invention except that using a transfer drum instead of a transfer belt. Roth shows that using a transfer drum and a transfer belt is an equivalent structure known in the art. Therefore, because the transfer drum and transfer belt were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute transfer belt for a transfer drum for purpose of transferring an image.

Roth discloses the claimed invention except that using a cleaning wand (Fig.1: element 30) instead cleaning roller. Dolan et al shows that using cleaning pad and cleaning roller (Column 3: line 42-46) is an equivalent structure known in the art. Therefore, because cleaning pad and cleaning roller were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a cleaning roller for cleaning pad for purpose of cleaning the transfer member.

2. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake (JP 3-284948) in view of Premnath et al. (USPN 6,283,576).

Miyake discloses the claimed invention except that using a full line head instead of a scanning head. Premnath et al shows that using a full line head and a scanning head is an equivalent structure known in the art. Therefore, because the full line head and scanning head were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a scanning head for a full line head for purpose of printing an image.

3. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake (JP 3-284,948) in view of Roth (USPN 6,354,700) as applied to claims 1 and 34 above, further in view of Moser (USPN 5,723,251)

The combination of Miyake and Roth fails to teach absorbing carrier fluid from ink of image with the transfer belt.

Moser teaches absorbing carrier fluid from ink of image with the transfer belt (Column 4: line 12-17, column 10: line 1-5, line 28-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made as modify to absorb carrier fluid from ink of image with the transfer belt as taught by Moser et al. The motivation of doing so is to increase the solid to liquid ratio of the image by absorptive action of the intermediate transfer member.

4. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake (JP 3-284948) in view of Ozawa et al. (USPN 5,365,261)

Miyake fails to teach ink is having an electrical charge.

Ozawa et al. teaches ink is having an electrical charge (Column 6: line 3-60)

It would have been obvious to one having ordinary skill in the art at the time the invention was made with ink is having an electrical charge as taught by Ozawa. The motivation of doing so is to reduce bleed characteristics (Column 3: line 54-55)

6. Claims 44, 46, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth (USPN 6,354,700) in view of Ozawa et al. (USPN 5,365,261).

With respect to claim 44, Miyake discloses an apparatus of printing with an ink jet comprising:

- Ink comprising a carrier fluid (Fig.1: element 1)
- An ink jet head (Fig.1: element 1) using the ink for printing images on a transfer member (Fig.1: element 2) that is adjacent to the print head and moveable with respect to the print head.
- The transfer member disposed to transfer an image to the print medium (Fig.1: 2, 5)

With respect to claim 46, Miyake discloses transfer member comprises a drum (Fig.1: element 2).

With respect to claim 48, Miyake discloses a pinch roller for facilitating transfer of an image from the transfer member to the medium (Fig.1: element 4).

With respect to claim 50, Miyake discloses a heating element for heating the transfer member (Fig.1: element 3).

However, Miyake fails to teach electrical charge facilitates transfer of the image to the medium.

Ozawa et al. teaches ink is having an electrical charge facilitates transfer of the image to the medium (Column 6: line 3-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made with ink is having an electrical charge as taught by Stoffel et al. The motivation of doing so is to reduce bleed characteristics (Column 3: line 54-55)

7. Claims 45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake (JP 3-284948) in view of Ozawa et al. (USPN 5,365,261) as applied to claim 44 above, further in view of Roth (USPN 6,354,700).

Miyake and Ozawa fails to teach the cleaning member and using transfer belt.

Roth discloses a cleaning member to clean the transfer member (Fig.1: element 30)

Miyake discloses the claimed invention except that using a transfer drum instead of a transfer belt. Roth shows that using a transfer drum and a transfer belt is an equivalent structure known in the art. Therefore, because the transfer drum and transfer belt were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute transfer belt for a transfer drum for purpose of transferring an image.

Roth discloses the claimed invention except that using a cleaning wand (Fig.1: element 30) instead cleaning roller. Dolan et al shows that using cleaning pad and



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cleaning roller (Column 3: line 42-46) is an equivalent structure known in the art.

Therefore, because cleaning pad and cleaning roller were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a cleaning roller for cleaning pad for purpose of cleaning the transfer member.

5. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake (JP 3-284948) in view Ozawa et al. (USPN 5,365,261) as applied to claim 44 above, further in view of Premnath et al. (USPN 6,283,576).

Miyake discloses the claimed invention except that using a full line head instead of a scanning head. Premnath et al shows that using a full line head and a scanning head is an equivalent structure known in the art. Therefore, because the full line head and scanning head were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a scanning head for a full line head for purpose of printing an image.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 33-51 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 33-51 of Application 10/616,668. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 33-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6639,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because scope of the claims invention 33-51 of Application 10/611,738 and scope of the claims invention of U.S. Patent 6,639,527 are the same.

***Response to Arguments***

8. Applicant's arguments filed July 1, 2003 have been fully considered but they are not persuasive.

Applicant's argument that Ozawa's electrical charge does not facilitate transfer of the image to the print medium is not persuasive because refer to column 6; line 3-60, Ozawa discloses to transfer the image using the charger 114. Therefore, Ozawa meets the limitation of the claim.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ly T TRAN whose telephone number is 703-308-0752. The examiner can normally be reached on M-F (7:30am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on 703-308-4896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0967.



January 26, 2004



Stephen D. Meier  
Primary Examiner